



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/575,369

04/11/2006

Marco Alexander Van Den Berg

4662-168

9073

23117

7590

06/04/2008

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

MONDESI, ROBERT B

ART UNIT

PAPER NUMBER

1652

MAIL DATE

DELIVERY MODE

06/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/575,369 | Applicant(s) VAN DEN BERG, MARCO ALEXANDER | |
| | Examiner ROBERT B. MONDESI | Art Unit 1652 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-9, drawn to a method for preparation of a modified host cell comprising: a) transfecting a host cell with at least one compound of interest to which a label is covalently coupled and b) isolating the transfected host cell; wherein the label provides to the host cell a non-inheritable trait.

Group II, claim(s) 10-14, drawn to method for preparation of a desired compound by a transformed host cell comprising: a) transfecting a host with at least one polynucleotide involved in production of said desired compound and which is covalently coupled to a label which provides to the host cell a non-inheritable trait, b) isolating the transfected host, c) culturing the transfected host under proliferating conditions, d) culturing the transfected host under conditions wherein the desired compound is produced, and e) isolating the desired compound from the culture broth.

Group III, claim(s) 15-20, drawn to a method for preparation of a desired metabolite by a transformed host cell comprising: a) transfecting a host cell with at least one polynucleotide involved in production of said desired metabolite and which is covalently coupled to a label which provides to the host cell a non-inheritable trait, b) isolating the transfected host cell, c) culturing the transfected host cell under proliferating conditions, d) culturing the transfected host cell under conditions wherein the desired metabolite is produced, and e) isolating the desired metabolite from the culture broth.

Group IV, claim(s) 21-25, drawn to a method for preparation of a desired biomass by a transformed host cell comprising: a) transfecting a host cell with at least one polynucleotide involved in production of said desired biomass and which is covalently coupled to a label which provides to the host cell a non-inheritable trait, b) isolating the transfected host, c) culturing the transfected host under proliferating conditions, d) culturing the transfected host under conditions wherein the desired biomass is produced, and e) isolating the desired biomass.

Group V, claim(s) 26, drawn to a polynucleotide for use in a method for preparation of a desired metabolite by a transformed host cell comprising: a) transfecting a host cell with at least one polynucleotide involved in production of said desired metabolite and which is covalently coupled to a label which provides to the host cell a non-inheritable trait, b) isolating the transfected host cell, c) culturing the transfected host cell under proliferating conditions, d) culturing the transfected host cell under conditions wherein the desired metabolite is produced, and e) isolating the desired metabolite from the culture bro, which modifies the cellular metabolism via redirecting metabolic fluxes towards said metabolite.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking Groups I-V appears to be that they all relate to the transformation of a host cell with a polynucleotide.

However, US Patent No. 6,608,213 teaches the transformation of a host cell with a polynucleotide (column 7, line 44 and column 8, line 3, figure 10).

Therefore the technical feature linking the inventions of Groups I-V does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

Accordingly, Groups I-V are not so linked by the same or a corresponding special technical feature as to form a single inventive concept.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT B. MONDESI whose telephone number is (571)272-0956. The examiner can normally be reached on 9am-5pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nashed Nashaat can be reached on (571)272-0934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert B Mondesi/
Primary Examiner
Art Unit 1652

Application/Control Number: 10/575,369
Art Unit: 1652

Page 5